

REMARKS/ARGUMENTS

By the foregoing amendment, a minor correction has been made to claim 36 to provide clear antecedent basis.

In response to the restriction requirement office action dated March 3, 2009, Applicant provisionally elects, with traverse, to prosecute Group II (claims No. 45-54) directed to a method for repairing a subject's hip joint.

Applicant traverses the restriction requirement on grounds that, as amended, claims 36-44 of Group I are not patentably distinct from the claims 45-54 of Group II and, thus, Groups I and II should be combined and claims 36-54 should be examined on the basis of Applicant's above-stated election.

MPEP 806.05 (h) states as follows:

806.05(h) Product and Process of Using [R-3]

A product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product; or (B) the product as claimed can be used in a materially different process.

The burden is on the examiner to provide an example, but the example need not be documented.

If the applicant either proves or provides a convincing argument that the alternative use suggested by the examiner cannot be accomplished, the burden is on the examiner to support a viable alternative use or withdraw the requirement.

In the office action, the Examiner contends that the device of claims 36-44 could be used for a materially different process than the one recited in claims 45-54. Specifically, in support of this contention, the Examiner states that the device could be used in a materially different process, "for instance for teaching purposes on a test dummy, or in an alternative surgical procedure, or in a method where body weight is not measured or in reaming a different bone structure in the body." Applicant respectfully disagrees and hereby requests reconsideration for the following reasons:

1) Method claims 45-54 are directed to a "method for repairing a subject's hip joint." These claims do not require the subject to be alive, nor do they require

the subject to be human. Thus, method claims 45-54 do encompass use of the device on a teaching dummy.

2) Merely making reference to “an alternative surgical procedure” is not an “example” as required by MPEP 806.05(h). Applicant is at a loss to know what “alternative surgical procedure” the Examiner is referring to. A specific example of such “alternative surgical procedure” must be provided in order to carry the Examiner’s burden under MPEP 806.05(h). Applicant does not believe that the claimed device could reasonable be used to perform an alternative surgical procedure.

3) The system claims are directed to a “system for performing an arthroplasty of a hip joint in a subject having one or more known body characteristics comprising at least body weight.” Additionally, these system claims specify that system includes “a plurality of prosthetic femoral heads having different radii of curvature that correspond to different predetermined body characteristics including at least body weight such that, when a prosthetic femoral head that corresponds to one or more predetermined body characteristics including at least body weight of a subject is selected and surgically implanted in that subject’s body such that it is received within an acetabular socket created by the reamer, a space will exist between the prosthetic femoral head and an inner surface of the acetabular socket and fluid having a hydrostatic pressure in the range of 0.01-5Mpa will accumulate in said space, thereby stimulating the formation of new cartilage between the prosthetic femoral head and the inner surface of the acetabular socket.” Given that the prosthetic head sizing is specifically correlated to one or more predetermined body characteristics including at least body weight it would be contrary to reason and would defeat the purpose of the device to attempt to use this device to perform a procedure without determining at least the subject’s body weight.

Accordingly, Applicant respectfully submits that it is not reasonable to require restriction between Groups I and II and such groups should be combined for purposes of examination.

Conclusion

For the foregoing reasons, examination of claims 36-54 is respectfully requested.

Applicant hereby petitions for a two (2) month extension pursuant to 37 C.F.R. 1.136 and the Commissioner is authorized to deduct the fee for such three month extension as well as any other fee properly deemed to be due in connection with the filing of this response from Deposit Account No. 50-0878. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, the Examiner is invited to contact Applicant's undersigned counsel.

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Respectfully submitted,

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